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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,632	05/01/2001	Andrew D. Dubner	56650US002	4391

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EXAMINER	
FRIDIE JR, WILLMON	
ART UNIT	**PAPER NUMBER**
3722	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/846,632	DUBNER ET AL.	
	Examiner	Art Unit	
	Willmon Fridie	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/24/05*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1,2,9,12,13,23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens in view of Smith.

Stephens discloses a security feature (16), a transparent fragile layer (12) and a transparent durable layer (12'). Further Stephens inherently teaches the method in claims 23 and 24 and substantially all of the subject matter set forth in the claims except for the claimed layer materials and indicia on one of its transparent layers . Smith discloses that it is well known in the art to provide indicia on a transparent layer associated with an information bearing assembly (see column 2, lines 10-16). It would have been obvious to a skilled artisan at the time of the invention was made to provide

Stephens with indicia on one of its transparent layers in the manner as taught by Smith in order to provide more information to the user.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens as modified by Smith as applied to claims 1,2,9,12,13,23 and 24 above, and further in view of Killey.

Stephens as modified by Smith discloses the claimed invention and substantially all of the subject matter set forth in the claims except for a holographic layer. Killey discloses and teaches that it is well known in the art to use a holographic foil layer in its assembly. It would have been obvious to a skilled artisan at the time of the invention was made to provide Stephens as modified by Smith with a holographic layer in the manner as taught by Killey in order to enhance the security feature .

Claims 4,6-8,10,11,14-16,19,20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens as modified by Smith as applied to claims 1,2,9,12,13,23 and 24 above, and further in view of McConville et al..

Stephens as modified by Smith discloses all of the subject matter set forth in the claims except for a retro reflective layer of glass beads . McConville discloses and teaches that it is well known in the art to use retro reflective layer of glass beads (24), hot melt adhesive (32), a protective coating lacquer coating and an index coating (26) in his

assembly. It would have been obvious to a skilled artisan at the time of the invention was made to provide Stephens as modified by Smith with a retro reflective layer of glass beads, hot melt adhesive and a protective coating lacquer coating and an index coating (26) in the manner as taught by McConville et al. in order to enhance and protect the security feature .

McConville et al. further teaches that it is well known in the art to use a composite assembly of the claimed elements in a document of value (see column 1, lines 25-65).

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stephens as modified by Smith as applied to claims 1,2,9,12,13,23 and 24 above, and further in view of Killey and McConville et al.

It would have been obvious to a skilled artisan to provide Stephens as modified by Smith with a multi-layer optical film layer and a holographic foil layer in the manner as taught by McConville et al and Killey for the reasons stated in the previous paragraphs.

Response to Arguments

Applicant's arguments filed 5/26/05 have been fully considered but they are not persuasive.

In response to applicant's argument that Stephens provides a plastic envelope. The examiner submits that applicant has not disclosed any criticality to the use of a "fragile" or "durable" layer in his assembly. Stephens discloses two layers made of a thermoplastic material. It does not preclude a composite plastic material where different sections consist of different polymers to inherently provide layers of different/relative

durability. Further, there is no recitation defining the function of the "fragile" or "durable" layer. There is no recitation explaining its use in fraud detection or tampering.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specifics of the "durable" and "fragile" layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the cited references are clearly in the field of endeavor of applicant's claimed invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Willmon Fridie whose telephone number is 571 272 4476. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571 272 4502. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WILLMON FRIDIE, JR.
PRIMARY EXAMINER